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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,418	10/22/2003	Yixing Lin	008716 USA/CPS/IBSS/LAP	6173
61285 7590 04/06/2007 JANAH & ASSOCIATES, P.C. 650 DELANCEY STREET, SUITE 106 SAN FRANCISCO, CA 94107			EXAMINER MILLER, DANIEL H	
			ART UNIT	PAPER NUMBER
			1775	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/06/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/691,418

Applicant(s)

LIN ET AL.

Examiner

Daniel Miller

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1775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/19/2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10, 11 and 18-38 is/are pending in the application.
- 4a) Of the above claim(s) 10 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Newly submitted claims 10 and 11 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: They describe an article that can be made from original parts not as part of a refurbishment process (as claimed by applicant. Also see previous restriction.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 10 –11 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 18-20, 22-34, and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by Lin et al (US 2003/0026917A1).

The applied reference has a common Assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

It is noted that the examined claims are product by process claims where in the examiner has taken the claims to claim the article that is the final product of the process. It is noted that the intermetallic compound is removed during applicant's claimed product by process and is therefore not present in the final product (see applicant's claim 18 (ii)).

"[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.", (In re Thorpe, 227 USPQ 964,966). Once the Examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward

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with evidence establishing an unobvious different between the claimed product and the prior art product (In re Marosi, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983), MPEP 2113).

Lin teaches a plasma-processing chamber including walls [0002]. The surface is bead blasted to create surface roughness [0040], creating enhanced bonding of a top metal layer. The surface roughness is within applicant's claimed range [0040 page 5]. The underlying structure can be aluminum and the coating can comprise titanium (claim 5 reference).

The coating can be a twin wire arc spray coated layer (see [0043-0046]). The titanium comprising coating can be textured as well (see [0050] and figure 3).

Given that the structure of the disclosed art and the claimed invention are substantially similar and both undergo a bead blasting to a substantially similar surface roughness they would be expected to have like physical characteristics, as claimed by applicant.

3. Claims 18-38 are rejected under 35 U.S.C. 102(e), in the alternative, under 35 U.S.C. 103(a) as obvious over Wang et al (US 6,902,628).

The applied reference has a common Assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

It is noted that the examined claims are product by process claims where in the examiner has taken the claims to claim the article that is the final product of the process.

"[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.", (In re Thorpe, 227 USPQ 964,966). Once the Examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product (In re Marosi, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983), MPEP 2113).

Wang teaches a refurbished processing chamber component (abstract) such as the enclosures walls or sidewalls of a shield, deposition or cover rings (column 4 line 1-10). The component comprising an intermetallic layer (column 7 line 45-55), wherein the surface is optionally bead blasted to create surface roughness (column 7 line 62-68), creating enhanced bonding of a top metal layer (304, column 8 line 1-5). The underlying structure can be stainless steel or titanium (claim 7 and 8 ref.) and the metal coating can be titanium (claim 9 reference). Given that the structure of the disclosed art and the

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claimed invention are substantially similar they would be expected to have like physical characteristics as claimed by applicant.

Further regarding claims 27-38, Wang teaches bead blasting (column 7) and a twin wire arc spray coating (column 8 line 65-68) to create an optionally roughened coating surface over roughened component surface (column 10). The cleaning solution, used before bead blasting, can be HF and HNO₃ (column 5 line 35-40). Although, as stated above, the process is not necessarily indicative of patentability of the product, the substantial similarity in the processes of Wang and the current invention should give a substantially similar product, or in the alternative, would render the invention obvious.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 21, 35-36 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lin in view of Garg (US 5,009,966).

6. Lin, discussed above, is silent as to the base material being titanium.

7. Garg teaches a titanium or titanium alloy substrate a hard metal coating to protect against oxidation (abstract). The layers would be capable of refurbishment as claimed by applicant.

It is noted that the examined claims are product by process claims where in the examiner has taken the claims to claim the article that is the final product of the process.

"[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.", (In re Thorpe, 227 USPQ 964,966). Once the Examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product (In re Marosi, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983), MPEP 2113).

8. It would have been obvious to use the titanium base material as taught by Garg as the substrate material for Lin because of its inherent wear resistance valuable in applications of chamber construction.

Response to Arguments

9. Applicant's arguments with respect to all pending claims have been considered but are moot in view of the new ground(s) of rejection. The affidavit was considered, but the rejection has been maintained because the declaration was not a proper 1.131 declaration needed to swear behind a reference (see MPEP section 2136.05). If applicant intends to traverse the rejection based on a factual showing under a 1.132 declaration then applicant must show evidence. Applicant has not met the burden by a showing of evidence.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Miller whose telephone number is (571)272-1534. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on (571)272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Daniel Miller



JENNIFER MCNEIL
SUPERVISORY PATENT EXAMINER

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